

89. (NEW) An eyeglass device comprising:

a primary spectacle frame having two side portions, each of said portions having an extension with a front side, a rear side and a first magnetic member secured to said rear side,
an auxiliary spectacle frame including two side portions each having an arm extended therefrom, each of said arms containing a second magnetic member, said arms extending across a respective extension from said front side to said rear side so that said first and second magnetic members engage one another whereby said auxiliary spectacle frame is supported by said primary spectacle frame.

REMARKS

Upon entry of the above Amendment, claims 4 – 11, 13 – 27, 29 – 35 and 41- 66 will have been canceled, claims 12, 28 and 36 will have been amended and claims 67 – 89 will have been added. As a result of the above Amendment, claims 1-3, 12, 28, 36-41 and 67 – 89 will be pending in the reissue application, and the number of claims for consideration will have been reduced from 66 to 34. No new matter has been introduced by this Amendment. Entry and reconsideration are respectfully requested.

I- THE APRIL 4, 2001 INTERVIEW:

On April 4, 2001, an Interview was conducted with Primary Examiner Mai, Supervisor Ms. Georgia Epps, and SPREs Ed Glick and Clayton LaBalle. During the Interview the Office Action dated July 15, 1999, the Richard Chao Supplemental Reissue Declaration filed May 29, 2001, Applicant's November 22, 2000 response, and a set of proposed claims were discussed.

**1. DISCUSSION OF APPLICANT'S COMPLIANT
SUPPLEMENTAL REISSUE OATH 35 USC § 251**

The Richard Chao supplemental reissue declaration filed on March 29, 2001 was discussed during the interview, at which time both Examiner Mai and SPRE Glick indicated that the declaration was in complete compliance with the reissue rules. As a result, it is applicant's understanding that the Examiner's observations/rejections set forth at ¶s 2 and 3 of the July 1999 Office Action are moot and withdrawn, as indicated in the Examiner's Interview Summary Record.

**2. DISCUSSION OF REJECTION OF REISSUE CLAIMS 8, 9, 12, 13,
16-22, 25-35 AS CONTAINING NEW MATTER UNDER 35 USC § 251**

The rejection of claims 8, 9, 12, 13, 16-22, 25-35 under 35 USC § 251 as containing new matter, set forth in ¶(4) of the July 1999 Office Action, was discussed, and has been withdrawn. During the Interview, reissue claims 8, 9, 12, 13, 16-22, 25-35 as filed, and the claims set forth in the November 2000 Amendment were discussed. Applicant's representative argued that reissue claims 8, 9, 12, 13, 16-22, 25-35 presented when the reissue was filed on October 21, 1998, and the corresponding claims in Applicant's November 2000 Amendment, and the phrases objected to in the ¶(4) rejection under 35 USC § 251, do not contain new matter, and that each phrase objected to is in fact fully supported by the original application which matured into the Chao '207 patent.

For example, the "first magnetic members being coupled, but not in contact, with the second magnetic member," recited in claims 8, 9, 22 and 35 does not constitute new matter, and is fully supported by the original specification, claims and drawings. Similarly, the subject matter "the end portion of the arm of the auxiliary spectacle frame extended downward toward

the projection for hooking on the primary spectacle frame” in claims 25-33 does not constitute new matter, and is expressly taught at column 3 of the Chao patent for which reissue is sought. Similarly, the “securing the magnetic members to the side portions of the primary spectacle” feature recited in claims 12, 16, 18, 20, 34 and 35 does not constitute new matter, and is fully supported by the original specification, claims and drawings.

Further, according to the Interview Summary Record, the Examiner and applicant’s representative agreed that the language in the November 27, 2000 and March 1, 2001 Amendments overcame this rejection, and therefore the Examiner has expressly withdrawn the rejection under 35 USC § 251.

3. **DISCUSSION OF PROPOSED FIGURE 8**

Proposed Figure 8 was discussed during the Interview and objected to in ¶(5) of the July 1999 Office Action. At the interview the Examiner acknowledged that the Chao ‘207 patent at column 3 expressly teaches, “and the end portions of the arms 21 and/or the magnetic members 22 are slightly extended downward toward the projections 13 such that the arms 21 and the magnetic members 22 may hook on the primary spectacle frame 10...” However, in the ¶(5) objection to the drawing as containing new matter, set forth in the July 1999 Office Action, the Examiner indicated “the original disclosure does not support an arm which extends downward toward the projection for hook on the primary spectacle frame as shown in the newly added Fig. 8.” During the Interview, the Examiner clarified his objection by stating that he was not objecting to a downwardly extending end portion per se, but to the fact that the end portion extends laterally past the rear edge of the projection.

Applicant is of the opinion that the original specification supports new Figure 8 for at least the following reason. The disclosure at column 3 expressly states that the end portion of the arm extends downward towards the projection. In addition, the original specification expressly discloses that the end portion may hook onto the spectacle frame. The original Chao '207 patent also expressly discloses that the projection is part of the spectacle frame, to wit, "the primary spectacle frame including two rear and side portions each having a projection secured thereto." Since the original patent expressly states that the end portion of the arm can hook to the frame, this disclosure conveys to the skilled practitioner that the end portion can hook onto the frame, e.g., via the "extension 11" which is part of the frame, or to "the end of the projection" which is also part of the frame, to help retain the auxiliary frame on the primary frame.

In any event, during the interview, the Examiner indicated that claims directed to the feature, "the end portion of the arm of the auxiliary spectacle frame extended downward towards the projection for hooking on the primary spectacle frame," are supported by the original disclosure, and would not require a separate drawing figure to show this feature. Thus, the Examiner expressly waived the requirements of 37 CFR 1.83 with respect to this feature. Accordingly, Figure 8 and its corresponding description in the specification have been deleted.

4. **DISCUSSION OF NEW MATTER IN THE SPECIFICATION**

During the interview, applicant's representative discussed the objection to the specification set forth in ¶(6) of the July 1999 Office Action relating to the description of Figure 8. In view of the above Amendment, and as discussed above, reference to Figure 8 and its corresponding description in the reissue application have been eliminated. Accordingly, this objection is moot.

5. DISCUSSION OF REJECTION OF REISSUE CLAIMS 8, 9, 12, 13, 16-22, 25-35 AS CONTAINING NEW MATTER UNDER 35 USC § 112, 1ST ¶

The rejection of claims 8, 9, 12, 13, 16-22, 25-35 under 35 USC § 112, 1st ¶, as containing new matter, as set forth in ¶(8) of the July 1999 Office Action is withdrawn. During the April 4, 2001 Interview, Applicant's representative argued that reissue claims 8, 9, 12, 13, 16-22, 25-35, presented when the reissue was filed on October 21, 1998, and the phrases objected to in the ¶(8) rejection under 35 USC § 112, 1st ¶, do not contain new matter, and that each phrase objected to is in fact fully supported by the original specification, claims and drawings. Further, according to the Interview Summary Record, the Examiner and applicant's representative agreed that the language in the November 27, 2000 and March 1, 2001 Amendments overcame this rejection, and therefore the Examiner has expressly withdrawn the ¶(8) rejection under 35 USC § 112, 1st ¶.

6. DISCUSSION OF REJECTION OF REISSUE CLAIMS 1-35 UNDER 35 USC § 112, 1ST ¶

During the interview the phrases "at least one" and "engaged with," deleted from original patent claim 1 and its dependent claims were discussed. As the Examiner's Interview Summary Record indicates, Examiner Mai was insistent that the specification does not support a spectacle device where "at least one arm" extends over the side portion of the primary spectacle frame, i.e., that only one arm extends over the side portion. However, the Examiner did agree that it was not necessary for applicant to recite in claim 1 that the arms which extend over the upper side portion, also "engage with" the upper side portion. Although applicant does not share the Examiner's opinion that there is no support for reciting "at least one arm" in the claims, the

reissue claims have been amended to delete reference to "at least one" to advance prosecution of this reissue application. Accordingly, this rejection should be withdrawn.

**7. DISCUSSION OF REJECTIONS BASED ON THE
NISHIOKA PATENT AND TWINCOMB DOCUMENT**

Each of the rejections under 35 USC §102 set forth in the July 1999 Office Action was discussed at the Interview, but no agreement was reached, except to the extent that the Examiner agreed to reconsider the declarations submitted by applicant in support of applicant's position that the Twincomb documents are not available as prior art under 35 USC § 102(a) or any other provision of 35 USC § 102.

**II- RESPONSES TO REJECTIONS/OBJECTIONS RAISED
IN THE JULY 1999 OFFICE ACTION**

1. APPLICANT'S REISSUE OATH - 35 USC § 251

In the July 1999 Office Action, the Examiner in ¶s 2 and 3 thereof objected to the reissue declaration, and rejected the claims under 35 USC § 251. These objections/rejections are moot and have been withdrawn. In addition, during the April 4, 2001 interview, SPRE Ed Glick indicated that should all the specific errors identified in the supplemental reissue declaration be eliminated, a second, supplemental reissue declaration may be necessary.

Applicant respectfully submits that the supplemental reissue declaration filed in March 2001 specifically identifies at least one error still being corrected by this reissue, to wit:

VII. I verily believe the '207 patent is wholly or partly inoperative by failing to include the following description of FIG. 7, that describes the spacing

between the magnets 14 and 22 which “spacing” is clearly depicted in original application FIG. 7.

In one embodiment, as shown in FIG. 7, magnetic members 14 and 22 are not in contact with each other, magnetic members 14 and 22 are engaged with, but not supported on, each other. Instead, the arms 21 securing the magnetic member 22 is supported on an upper side portion of the primary spectacle frame 10. As shown in FIG. 7, the upper side portion can be an upper part of the side portion securing the projection 13.

Thus, applicant respectfully submits that no additional supplemental declaration should be required. In addition, applicant respectfully submits that the supplemental reissue declaration filed on March 29, 2001, when combined with the intent of the original reissue declaration, is sufficiently adequate to comply with the requirements of the rules, particularly in view of at least paragraphs 12 and 13 of the original declaration which identify numerous errors in the original Chao ‘207 patent, e.g., numerous features that were not expressly claimed in the Chao ‘207 patent.

2. **RESPONSE TO REJECTION OF REISSUE CLAIMS 8, 9, 12, 13, 16-22, 25-35 AS CONTAINING NEW MATTER UNDER 35 USC § 251**

Claims 8, 9, 12, 13, 16-22, 25-35 have been rejected under 35 USC § 251 as containing new matter as set forth in ¶(4) of the July 1999 Office Action. This rejection has been withdrawn, in view of applicant’s arguments that these claims do not contain new matter and are fully supported by the “original specification, claims and drawings,” and as acknowledged by the Examiner in the Interview Summary Record dated April 4, 2001.

3. **DISCUSSION OF PROPOSED FIGURE 8**

Proposed Figure 8 has been canceled and thus the objection to Figure 8 is moot. In addition, as discussed supra, Figure 8 is supported by the original Chao '207 patent disclosure. Since the Examiner indicated during the April 4, 2001 interview that he would waive the requirements of the rule to have a specific Figure for claims drawn to the downwardly extended end portion of the arm, 37 CFR § 1.83, applicant has decided not to provide any Figure 8 showing this feature.

4. **RESPONSE TO REJECTION OF REISSUE CLAIMS 8, 9, 12, 13, 16-22, 25-35 AS CONTAINING NEW MATTER UNDER 35 USC § 112, 1ST ¶**

Reissue claims 8, 9, 12, 13, 16-22 and 25-32 have been rejected under 35 USC § 112, 1st paragraph as containing new matter. According to the Examiner's Interview Summary Record, the Examiner and applicant's representative agreed that these claims and the phrases objected to in the ¶(8) rejection under 35 USC § 112, 1st ¶, do not contain new matter, and each phrase objected to is in fact fully supported by the original "specification, claims and drawings." Accordingly, this rejection is improper, and has been withdrawn.

5. **RESPONSE TO REJECTION OF REISSUE CLAIMS 1-35 UNDER 35 USC § 112, 1ST ¶**

Claim 1, and all other claims including the phrase "at least one" have been amended and the phrase deleted. The phrase "engaged with," deleted from original patent claim 1, and its dependent claims remain. During the Interview, the Examiner indicated that he no longer objected to the deletion of the phrase "engaged with." Therefore, it is respectfully submitted that this rejection is no longer applicable and the rejection should be withdrawn.

6. **RESPONSE TO REJECTION UNDER 35 USC § 112, 2ND ¶**

Claims 5-9, 10-13, 22 and 32-35 have been rejected under 35 USC § 112, 2nd ¶.

Applicant respectfully submits that the November 27, 2000 Amendment corrects the form of the claims and does not narrow the claimed invention. See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558 (Fed. Cir. 2000).

7. **RESPONSE TO THE REJECTION BASED ON THE
NISHIOKA PATENT**

Claims 12 and 34 have been rejected under 35 USC § 102 (e) as being anticipated by U.S. patent No. 5,642,177 (Nishioka). Applicant respectfully submits that the Nishioka patent does not teach or suggest the invention of claims 12 and 34 for reasons of record. Claim 34 has been canceled without prejudice or disclaimer for the subject matter recited therein.

The Nishioka patent, as previously argued in the November 27, 2000 Amendment, shows magnetic engagement along a vertical plane, which is not being recited in Claim 12. Further, a clarifying amendment to claim 12 has been made to more clearly distinguish the horizontal attraction between the first and second magnets. Accordingly, in view of the above Amendment to claim 12, it is respectfully submitted that this rejection is improper and should be withdrawn.

8. **RESPONSE TO THE REJECTION BASED ON
THE TWINCOMB DOCUMENTS**

Claims 1, 3-7, 10-21, 23, 24 and 34 have been rejected under 35 USC § 102(a) as being anticipated by Twincome-Pentax. Applicant respectfully traverses this rejection for all the reasons of record.

During the Interview, Examiner Mai informed the undersigned that he had not as of yet had an opportunity to evaluate the Richards Samuel's declaration filed in support of applicant's position, i.e., a declaration in support of the argument that with respect to the Le Coane meeting, any documents provided to the attendees do not constitute a publication because it was not a "public meeting." Applicant requests that the Examiner consider the Samuel's declaration which supports the proposition that any document provided during the Le Coane meeting does not constitute "a publication."

In addition, applicant respectfully submits that neither the documents provided during the Le Coane group meeting, nor those allegedly presented at the 1995 IOFT meeting constitute prior art. The Le Coane group meeting allegedly occurred on June 21, 1995, and the 1995 IOFT Meeting occurred in October 1995.

On October 8, 1998, Interference No. 104,051 (the '051 Interference) was declared between the Chao '207 patent (the involved Chao patent) and Iwamoto application Serial No. 08/655,828 (the involved Iwamoto application). The involved Iwamoto application had a filing date of May 31, 1996, and was accorded benefit of its Japanese priority applications, the earliest of which had a filing date of May 31, 1995. (Exhibit No. 1). Thus, Iwamoto was initially designated the senior party of the interference. Applicant's reissue declaration filed on October 21, 1998 notified the USPTO of the declared interference. The notice identified the opposing party, Iwamoto; the involved Iwamoto application serial number; and the counts of the interference. A copy of the index for party Chao's pleadings in the '051 Interference is attached for the Examiner's convenience. (Exhibit No. 2).

On April 23, 1999, the Board of Patent Appeals and Interferences (BPAI) issued their decision on Iwamoto's Revised Preliminary Motion 2. (Exhibit No. 3). In "denying" Iwamoto's Preliminary Motion 2, the BPAI set forth at least the following findings of fact:

5. Live testimony of Messrs. Richard and David Chao was taken by direct examination on February 24 and 25, 1999, in the presence of Judges McKelvey and Lee. ("Chao Interference Exhibit 1112")
6. Richard Chao came up with the idea within the scope of claim 1 in September or October of 1994 while taking a shower. (Chao Interference Exhibit 1112, page 191, lines 14-21).
7. Richard Chao considered his invention as that of creating a "hook" type engagement between the primary spectacle frame and the auxiliary spectacle frame. To Richard Chao, so long as the hook function is achieved, it did not matter to Richard Chao from what material the hook is made. (Chao Interference Exhibit 1112, page 206, lines 14-16).
8. After having initially thought of the idea of a hooked arrangement between the primary and auxiliary spectacle frames, Richard Chao shared his idea with other persons in discussions about his invention. The other persons included family members, for example, David Chao, a brother of Richard Chao. (Chao Interference Exhibit 1162, page 198, line 2 to page 199, line 22).
9. David Chao, after hearing Richard Chao's idea and discussing the same with Richard Chao, drew in his 1994 Day Planner, as an entry for September 5, 1994, a figure to depict what he thought Richard Chao had invented and communicated to him. (Chao Interference Exhibit 1105).
10. David Chao also drew in his 1994 day Planner, in the entry for October 20, 1994, another figure to depict what he thought Richard Chao had invented and communicated to him. (Chao Interference Exhibit 1106).
11. The drawings of David Chao on the September 5 and October 20, 1994, i.e., the entries of his Day Planner, illustrate a magnetic member extending downward from an auxiliary frame toward a projection on the primary spectacle frame holding a magnetic member, as does Figure 7 of the Chao patent. (Chao Interference Exhibits 1105 and 1106).

On April 7, 2000, the BPAI issued an Order that stated that the results of forensic ink-testing of David Chao's "Day Planner" "be unsealed and disclosed to the parties." (Exhibit No.

4) In the Order, the BPAI stated that "Counsel for the parties indicated that precisely which party will prevail depends on the results of the ink-testing that was performed previously by an independent expert." (Exhibit No. 4, p. 2.)

On or about May 26, 2000, Senior Party Iwamoto and Junior Party Chao filed a "Joint Motion for Entry of Adverse Judgment Against Senior Party Iwamoto." (Exhibit 5). On May 30, 2000, the BPAI entered judgment against senior party Iwamoto. According to the Judgment, Administrative Judge Lee ordered that "the subject matter of both counts 1 and 2 is herein entered against the senior party Toshikazu Iwamoto" and "senior party is not entitled to its application claims" 1, 3, 4, 7-9, 14-18 and 21-47. (Exhibit No. 6, p. 2)

In addition, as indicated by the attached David Y. Chao Declaration under 37 CFR § 1.131, David Y. Chao brought the same Day Planner referred to above in the finding of facts by the BPAI, which included the drawings of Chao Interference Exhibits 1105 and 1106 (Exhibits 8 and 9), and expressly mentioned in Exhibit No. 3, and at least one spectacle prototype device embodying Richard Chao's concepts, into the United States before May 31, 1995. (Exhibit No. 7). In addition, David Y. Chao stated in his declaration that "shortly before March 25, 1995, active exercise began and continued in a diligent effort toward reducing the inventive concepts illustrated in my Day Planner to practice in the US."

It is respectfully submitted that in view of the above evidence, the documents distributed at the Le Coane meeting and the IOFT '95 Tradeshow are not "prior art." Accordingly, the rejection of 1, 3-7, 10-21, 23, 24 and 34, or any of the pending claims under 35 USC § 102(a) based on the Twincomb documents is improper and should be withdrawn


AUTHORIZATIONS:

No petition or fee is necessary.

The Commissioner is also hereby authorized to charge any additional fees which may be required for timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4216-4000.

Respectfully submitted,

Date: April 20, 2001

By: 
Michael S. Marcus, Esq.
Registration No. 31,727
(202)-857-7887 Telephone
(202)-857-7929 Facsimile

Correspondence Address:
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, New York 10154
(212) 758-4800 Telephone
(212) 758-6849 Facsimile

09/182,862-020401
FBI/DOJ-22838788